

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Koichi ENDO et al

Application No.: 09/485,583

Filed: February 14, 2000

For: REMEDIES FOR DISEASES ASSOCIATED...

Art Unit: 1617

Examiner: K. Stiller

Washington, D.C.

Atty.'s Docket: ENDO=12

Date: August 17, 2001

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

Transmitted herewith is a [X] REPLY TO ELECTION REQUIREMENT in the above-identified application.

[] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted

[] A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.

[XX] No fee is required.

The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*	MINUS	** 20	0
INDEP.	*	MINUS	*** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

ADDITIONAL FEE TOTAL

SMALL ENTITY

RATE	ADDITIONAL FEE
x 9	\$
x 40	\$
+ 135	\$
ADDITIONAL FEE TOTAL	

OR

OTHER THAN SMALL ENTITY

RATE	ADDITIONAL FEE
x 18	\$
x 80	\$
+ 270	\$
TOTAL	

OR

- * If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
 ** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
 *** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[XX] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- [] First - \$ 55.00
 [] Second - \$ 195.00
 [] Third - \$ 445.00
 [] Fourth - \$ 695.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

- [] First - \$ 110.00
 [XX] Second - \$ 390.00
 [] Third - \$ 890.00
 [] Fourth - \$ 1390.00

Month After Time Period Set

[] Less fees (\$) already paid for month(s) extension of time on

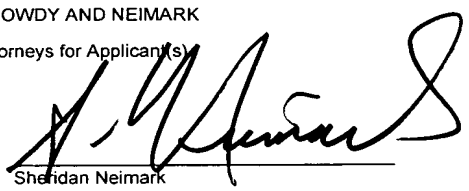
[XX] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$390.00.

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: ENDO=12

In re Application of:)	Art Unit: 1617
Koichi ENDO et al)	Examiner: K. Stiller
Appln. No.: 09/485,583)	Washington, D.C.
Date Filed: February 14, 2000)	Confirmation No.
For: REMEDIES FOR DISEASES)	August 17, 2001
ASSOCIATED WITH BONE...)	

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REPLY TO ELECTION REQUIREMENT

Honorable Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants acknowledge receipt of Paper No. 5, an Office Action mailed May 22, 2001, solely in the nature of a requirement for election of species. A petition for two months' extension of time is attached hereto.

Applicants respectfully request the PTO to acknowledge receipt of applicants' papers filed under Section 119.

An election of species has been made for applicants to elect a single individual compound from among all those claimed in the method and kit claims presently pending, as well as a single bone resorption associated disease.

As regards the first said requirement, applicants hereby provisionally and respectfully elect L-N-6-(1-iminoethyl)lysine with traverse and without prejudice. This compound is mentioned at page 8, line 3, and Example 1 of the specification.

As regards the disease, applicants hereby respectfully and provisionally elect osteoporosis with traverse and without prejudice.

The PTO recognizes that normal election practice does not apply to the present case because it is the national stage of a PCT application, and therefore PCT "unity of invention" rules apply.

During the international stage, as can be seen from the IPER, all of applicants' claims 1-7 pending at that time were considered. There was no lack of unity of invention. The PTO should follow the lead of the initial PCT examination, as the criteria are identical.

As regards applicants' compounds, they are chain amidine derivatives, cyclic amidine derivatives, 2-aminopyridine derivatives and guanidine derivatives. Please see page 6, line 18 to page 10, line 3 of the present specification. As all of these derivatives have the common pharmacological action of inhibiting iNOS, it is clear that

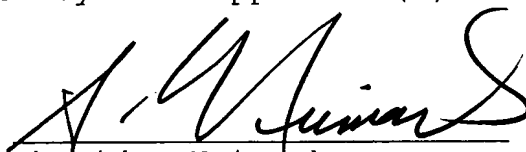
The Office Action also requires applicant to identify the claims readable on the elected species. However, the examiner has already done so and has noted that all claims are generic. Accordingly, all the claims read on the elected species, except possibly claims 5-7, 12-14 and 19-21 as regards the disease entity.

Applicants respectfully await the results of an examination on the merits.

Respectfully submitted,

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